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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/631,052

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Albert N. Santilli

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EXAMINER

BACHMAN, LINDSEY MICHELE

ART UNIT

PAPER NUMBER

3734

MAIL DATE

DELIVERY MODE

11/16/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/631,052

Applicant(s)

SANTILLI, ALBERT N.

Examiner

Eric Blatt

Art Unit

3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 3-11-2004.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: ____.
- ☐ Notice of Informal Patent Application
- ☐ Other: ____.

DETAILED ACTION

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-13 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-13 of prior U.S. Patent No. 6,610,074. This is a double patenting rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 17, claim 17 recites "the slot" wherein more than one slot has been previously recited.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14-15 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donlon et al. (US 5,618,307) in view of Sasaki (US 5,081,811).

Regarding claims 14-15, Donlon discloses an aorta cross clamp assembly (Figures 25-27) comprising:

- a clamp having first 308B and second jaws 310B that are movable toward and away from each other;
- an elongate housing 346B having first and second ends, the clamp being connected to the first end;
- an elongate actuator 378 disposed within the housing and operatively connected to the jaws such that axial movement of the actuator within the housing causes the jaws to move toward or away from each other;
- a retainer 324B disposed within the housing,
- a handle 394 connected to the second end of the housing;

- and a stem 380 connected to the actuator, the stem projecting outwardly of the handle, the stem permitting the user to operate the actuator in either the first or second modes of operation permitted by the retainer; and
- the first jaw is fixed and the second jaw is movable toward or away from the first jaw.

This embodiment shown in Figures 25-27 of Donlon does not disclose:

- the retainer having two modes of operation, the retainer in the first mode permitting the actuator to move within the housing such that the jaws are moved toward each other but not away from each other, and the retainer in the second mode permitting the actuator to be moved within the housing such that the jaws are moved away from each other;

The clamp embodiment shown in Figures 25-27 is actuated only by rotating the inner actuating member 378 relative to the housing 346B. In Figures 17-22, however, Donlon discloses a similar remote clamping apparatus that has two modes of operation wherein a retainer 342 has two modes of operation such that the retainer in the first mode permits the actuator to move within the housing such that jaws are moved toward each other but not away from each other, and the retainer in the second mode permits the actuator to be moved within the housing such that the jaws are moved away from each other. Both embodiments have the benefit of being locked in the clamped configuration until the user chooses to release the lock, but the embodiment of Figures 17-22 has the additional advantage of being more quickly and easily manipulated into the clamped configuration. Although this property would be desirable in the embodiment of Figures 25-27, the particular ratcheting locking mechanism of Figures 17-22 would not combine well with the threaded actuating mechanism of Figures 25-27. Sasaki discloses a retaining element 11 that is a nut with a slot therethrough which allows a threaded member to be quickly and easily pushed axially through said retainer in one direction but requires that the threaded member must be rotated relative to the retainer to move it axially in the second direction. (Column 4, Lines 47-59) It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus of Donlon (Figures 25-27) by providing the retainer of Sasaki in order to allow the clamp to be quickly and easily moved into

the clamped configuration and then locked in said clamped configuration as taught by Donlon (Figures 17-22) and Sasaki.

Regarding claim 18, the embodiment shown in Figures 25-27 of Donlon does not disclose:

- the housing is flexible and the actuator is a cable.

This clamp is designed to reach its target site in the body linearly and thus does not require flexible components. (Figure 23) The embodiment shown in Figures 7-9 of Donlon has a flexible housing and inner member so that it may curve to approach its target site. (Column 9, Line 53 through Column 10, Line 15) It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus shown in Figures 25-27 by making the housing and the actuator flexible as taught by the embodiment shown in Figures 7-9 of Donlon for purposes such as allowing the device to curve to approach its target site. The modified actuator 378 is a cable.

Regarding claim 19, Donlon additionally discloses:

- the second end of the housing includes a fitting to which the handle is secured, and the stem has a knob. (Figure 25, Column 16, Lines 1-23)

Thus, the embodiment shown in Figures 25-27 of Donlon discloses all elements of claim 19 except:

- the handle has a pair of finger loops.

Donlon states that although the handle 280 is shown as a disc, it may also be any other conventional hand grip. (Column 16, Lines 20-23) In Figure 1, Donlon shows a handle having a pair of finger loops. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus of Donlon (Figures 25-27) by providing a pair of finger

loops as taught by the embodiment shown in Figure 1 since this handle was a known alternative and would have produced expected results.

Claims 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donlon et al. (US 5,618,307) in view of Sasaki (US 5,081,811) as applied to claims 14-15 above, and further in view of Hasson (US 5,211,655).

Regarding claim 16, Donlon additionally discloses:

- a base 324B having a bore therethrough; a slot in the first jaw, the second jaw being disposed within the slot; and a hinge pin 316B extending through the slot and the second jaw to support the second jaw for pivotal movement within the slot.

Thus, all elements of claim 16 are disclosed by Donlon in view of Sasaki as previously discussed except:

- the first jaw is connected to the base.

The clamp disclosed in Donlon is actuated by moving both jaws axially relative to the housing and base via the actuator. Since both jaws move axially with the actuator, the static first jaw is not fixed to the base. Hasson discloses a clamp (Figure 5a) with a hinging mechanism wherein the first static jaw 48 is fixed to a base and the second jaw 46 moves axially with the actuator to open and close the clamp jaws. It would have been obvious to substitute the hinging mechanism of Donlon with the hinging mechanism disclosed in Hasson since they were known alternatives at the time of the invention and their substitution would have produced expected results.

Regarding claim 17, the modified device of Donlon additionally discloses:

- the retainer includes: a screw 320B disposed within the bore, the screw having first and second ends; a nut 392 (modified as taught by Sasaki) connected to the base, the screw passing through the nut, the connection between the nut and the screw being such that the screw can move toward the second jaw without rotating but the screw can move away from the second jaw only by being rotated;
- a slot in the second jaw (modified as taught by Hasson); and
- and a drive connector 386/378 connected to the second end of the screw, the actuator being connected to the connector in driving relationship.

Thus, all elements of claim 17 are disclosed by Donlon in view of Sasaki and further in view of Hasson except:

- a link rotatably connected to the first end of the screw and connected to the second jaw by a pin passing through the link and the slot;

The second jaw of the modified device is connected to the actuator by a pin passing through the slot in the second jaw and the actuator. Since the second jaw of the modified device is axially displaced by rotation of the actuating screw, there must be a link between the second jaw and the screw such that the second jaw does not rotate with the screw when they are axially displaced together. The examiner takes official notice that it is notoriously old and well known in the art to provide a link between elements to allow axial motion to be transferred between said elements without also transferring their rotational motion. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide a link rotatably connected to the first end of the screw and connected to the second jaw by a pin passing through the link and the slot in order to allow the second jaw to be moved axially without also transferring the rotational motion of the screw.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Smith; Stephen B. (US 6,146,392): Needle holding and manipulating instrument.
- Sherman; Benjamin et al. (US 5,928,253): Integrated cannula and vascular clamp assembly.
- Morejohn; Dwight P. et al. (US 6,146,394): Vascular clamp and method for using the same.
- Brown; Ivan E. (US 3,506,012): Polyp clamp and applier therefor.
- Sherman; Benjamin, (US 5,921,996): Surgical clamp applier/remover and detachable clamp.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Blatt whose telephone number is 571-272-9735. The examiner can normally be reached on Monday-Friday, 9:00 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hayes can be reached on 571-272-4959. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Eric Blatt
571-272-9735

A handwritten signature in black ink, appearing to read "M J Hayes", written in a cursive style.

MICHAEL J. HAYES
SUPERVISORY PATENT EXAMINER